



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/321,987	05/28/1999	JUDITH E. KIMBLE	960296.95386	7352

26734 7590 12/17/2002

QUARLES & BRADY LLP
FIRSTAR PLAZA, ONE SOUTH PINCKNEY STREET
P.O. BOX 2113 SUITE 600
MADISON, WI 53701-2113

EXAMINER

SHUKLA, RAM R

ART UNIT PAPER NUMBER

1632

DATE MAILED: 12/17/2002

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/321,987

Applicant(s)

KIMBLE ET AL.

Examiner

Ram R. Shukla

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1632

DETAILED ACTION

1. Applicants' response and amendments filed 10-2-02 has been received and entered.
2. New claims numbered 14-16 have been entered. Regarding the newly presented claims, it is noted that the numbering of claims is not accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 14-16 have been renumbered as claims 28-30.

3. Claims 1-10, 13 and 28-30 are pending.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-10, 13 and 28-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for selecting a modulator of a gonadal cell migration activity in a nematode, said method comprising: treating a nematode with at least one potential modulator; observing in the treated nematode a change in the migration activity of the gonadal cell, wherein the change is not observed after treatment with the at least one potential modulator of a mutant of the nematode that comprises the cell but does not comprise the protein, wherein the change in the migration activity results in the identification of the modulator, wherein the nematode is selected from the group consisting of C.

Art Unit: 1632

elegans and C.briggsae, wherein the migration activity is selected from the group consisting of elongation and expansion, wherein the migration activity is regulated by a protein comprising a metalloprotease domain and a thrombospondin domain, wherein the protein is a wild type protein of SEQ ID NO 2 or a protein encoded by the heterologous polynucleotide sequence of SEQ ID NO 1 under the control of a promoter functional in the nematode or a chimeric protein comprising the metalloprotease and thrombospondin domains of SEQ ID NO 2 or wherein the protein is selected from the group consisting of murine ADAMTIS-1 protein, bovine procollagen-1 N-proteinase and human aggrecan-degrading metalloprotease, does not reasonably provide enablement for any protein that shares at least 20% sequences identity with metalloprotease and thrombospondin domains of SEQ ID NO2 or any truncated protein for reasons of record set forth in the previous office action of 3-26-02, 6-25-01, 12-13-00 and as discussed below. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Response to Arguments

Applicant's arguments filed 10-2-02 have been fully considered but they are not persuasive to obviate all the issues of rejection discussed in the previous office actions. It is noted that while applicants' amendments to claims 1 and 6-9 obviate some issues raised in the previous office actions, the amendments and arguments do not obviate the rejections pertaining to any protein that shares at least 20% sequences identity with metalloprotease and thrombospondin domains of SEQ ID NO2 or any truncated protein. As noted in the previous office action of 12-13-00, regarding the practice of the methods wherein the target protein has 20% sequence similarity to a protein with metalloprotease and thrombospondin domains, the issue remain: the specification does not teach how to make a protein in which 80% of the amino acids in the metalloprotease and thrombospondin domains are altered

Art Unit: 1632

and the protein still is functional. Likewise, the specification does not treat how to make and truncated protein that will retain the functional activity. As stated by the applicants, during the personal interview on August 9, 2002, while some of the aspects of the rejection were resolved and clarified, amendments do not address all the issues.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-10, 13 and 28-30 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because recites the term "when the cell is under the influence of a protein". It is noted that the term used is not an art recognized term and the specification does not provide any definition for the term as to what will be encompassed by the term "when the cell is under the influence of a protein". Accordingly, the metes and bounds of the claimed invention are not clear.

Claim 1 recites the limitation "the treated nematode" in line 8. There is insufficient antecedent basis for this limitation in the claim because the claim does not recite the term "a treated nematode". Recitation of the term "thereby producing a treated nematode" in the first step of the claim will be remedial.

8. No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1632


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

When amending claims, applicants are advised to submit a clean version of each amended claim (without underlining and bracketing) according to § 1.121(c). For instructions, Applicants are referred to <http://www.uspto.gov/web/offices/dcom/olia/aipa/index.htm>.

Applicants are also requested to submit a copy of all the pending/under consideration claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached on (703) 305-4051. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature, formal matters or relating to the status of this application or proceeding should be directed to the Tiffiany N. Tabb whose telephone number is (703) 605-1238.

Ram R. Shukla, Ph.D.


RAM R. SHUKLA, PH.D
PATENT EXAMINER